

REMARKS

This is a full and timely response to the non-final Official Action mailed **June 10, 2009** (the "Office Action" or "Action"). Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

Under the imposition of a previous Restriction Requirement, claims 25-31 have been withdrawn from consideration and are labeled accordingly above. Claims 1-16 were previously cancelled without prejudice or disclaimer.

By the foregoing amendment, only claim 17 has been amended. No new matter has been added. The amendment to claim 17 corrects a minor discrepancy and is not intended to change or narrow the scope of claim 17.

Claims 17-24 are currently pending for further action.

Prior Art:

Claims 17-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,459,906 to Yang ("Yang"). For at least the following reasons, this rejection is respectfully traversed.

Claim 17:

Claim 17 recites:

A method for remotely monitoring a residence comprising:
generating a *trigger initialized digital image* in a *surveillance device*;
transmitting a trigger alert signal directly to a wireless communication device over
a private network; and
*enabling an image transmission between said surveillance device and said
wireless communication device regardless of a service provider of said wireless
communication device.*

(Emphasis added).

Applicant wishes to remind the Examiner of the substantial burden that must be overcome to establish a *prima facie* case of anticipation. "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim."

Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983). Thus, "[a] claim is anticipated [under 35 U.S.C. § 102] only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131.

The present rejection of claim 17 does not come close to meeting this burden. Specifically, Yang does not anticipate claim 17 at least because Yang fails to teach or suggest "generating a trigger initialized digital image in a surveillance device" and "enabling an image transmission between said surveillance device and said cell phone regardless of a service provider of said wireless communication device." (Claim 17).

In contrast, Yang teaches a system for "the communication of a character message received when viewing a TV program in a TV mode of a TV phone without interfering with the

user's viewing of the TV program.” (Yang, col. 2, lines 5-9). According to Yang, “when the TV phone is set to a TV mode, an alarm informs the user of the incoming call.” (*Id.*, col. 3, lines 15-16). Yang further teaches that this alarm may “switch an image onto the display of the TV phone, or it may display a call incoming message at a specific region on the TV display.” (*Id.*, col. 3, lines 15-21).

In the first place, the Action is not clear with regard to which specific teachings in Yang it is alleging to read on the “surveillance device,” the “wireless communication device,” or the “cell phone” of claim 17. The Action merely asserts that Yang teaches all of the subject matter of claims 17-24 while citing generally to a number of large portions of Yang that recite multiple devices and configurations. (Action, p. 2) (citing to Yang, col. 2 lines 12-34, col. 3 lines 14-44, col. 4 lines 15-31, and col. 5 lines 17-45). It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this reason alone, the rejection of claim 17 fails and should be withdrawn.

Despite the Action's failure in this regard, it is nonetheless clear that neither the TV phone nor the cell tower sending an incoming call to the TV phone, nor a TV broadcaster broadcasting to the TV phone taught by Yang can possibly read on the “surveillance device” recited in claim 17.

In the first place, the meaning of words used in the claims is determined by the meaning given to those words in the specification. *Markman v. Westview Instruments*, 116 S. Ct. 1384 (1996); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 674 (Fed. Cir. 1984); *ZMI Corp. v. Cardiac*

Resuscitator Corp. 884 F.2d 1576, 1580, 6 U.S.P.Q.2d 1557, 1560-61 (Fed. Cir. 1988) ("words must be used in the same way in both the claims and the specification."). Applicant's specification and the context of claim 1 both indicate that a surveillance device is used to capture images while "remotely monitoring an area of interest." (Applicant's specification, ¶¶ 0001-02). Moreover, it is well known and accepted by those having skill in the art that a "surveillance device" is a device, generally a camera, used to keep close watch over a location. "The words of [a] claim must be given their plain meaning unless the plain meaning is inconsistent with the specification." MPEP § 2111.01; *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004).

To construe the TV phone taught by Yang as a "surveillance device" simply because a user watches TV programming through the phone is inconsistent with both the meaning given to the term "surveillance device" by the specification and its plain meaning. To interpret the a cell phone tower communicating with the TV phone taught by Yang as the "surveillance device" is also consistent with these meanings. Moreover, such an interpretation is inconsistent with claim 17, which recites that "a trigger initialized digital image" is generated in the surveillance device. (Claim 17). Yang does not teach or suggest anywhere that "a trigger initialized digital image" is generated within a cell phone tower. (*Id.*) To interpret a TV broadcaster transmitting a TV signal to the TV phone of Yang as the "surveillance device" also fails, since Yang does not teach or suggest anywhere that a "trigger initialized digital image" consistent with claim 17 is generated in the TV broadcaster. (*Id.*)

The fact that Yang fails to teach or suggest the surveillance device recited in claim 17 is significant, since “[t]he materials on which a process is carried out must be accorded weight in determining the patentability of a process. *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974).” (See MPEP § 2116). Consequently, the surveillance device recited in the method of claim 17 must be considered in determining the patentability of the method. Because Yang fails to teach or suggest such a surveillance device, Yang *cannot* teach or suggest “generating a trigger initialized digital image in a surveillance device.” (Claim 17).

Nevertheless, even if Yang did teach a surveillance device, it would still fail to teach or suggest “enabling an image transmission between said surveillance device and said cell phone regardless of a service provider of said wireless communication device.” (Claim 17). Again, because of the improper ambiguity of the rejection, it is unclear which subject matter in Yang the Examiner is alleging to read on the “surveillance device” recited in claim 17. However, taking this ambiguity in stride, Applicant notes that no possible interpretation of Yang is sufficient to teach or suggest this subject matter.

To interpret the TV phone of Yang to read on the “surveillance device” in this clause would be contradictory, since such an interpretation would require the TV phone of Yang to transmit an image to itself. In addition to this interpretation failing the test of logic, Yang does not teach or suggest that its TV phone is configured to do so.

An interpretation of the cell phone tower of Yang as reading on the “surveillance device” in this clause also fails, because Yang does not teach or suggest transmitting images from the cell phone tower to its TV phone. Rather, the only images that Yang teaches as being transmitted to the TV phone are TV images received by a separate TV broadcaster.

Finally, to interpret a TV broadcaster in Yang as the surveillance device in this clause also fails, since such an interpretation would also require that Yang teach or suggest that the TV broadcaster “generate[s] a trigger initialized digital image.” (Claim 17). Yang simply does not teach or suggest this subject matter anywhere.

Respectfully, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown *in as complete detail as contained in the ... claim.*” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). For the reasons explained above, the present Action cited to Yang utterly fails to meet this burden. Consequently, the rejection based on Yang of claim 17 and its dependent claims has unnecessarily burdened the inventor and should be reconsidered and withdrawn.

Additionally, various dependent claims subject to the present rejection recite subject matter that is further patentable over the prior art of record. Specific, non-exclusive examples follow.

Claim 18:

Claim 18 is patentable over Yang for at least the same reasons given above in favor of the patentability of claim 17. Additionally, claim 18 recites:

wherein said transmitting a trigger alert signal over a private network comprises:
transmitting said trigger alert signal from said surveillance device to a telephone exchange over a standard telephone line;
transmitting said trigger alert signal from said telephone exchange to a mobile telecommunications switching office; and
transmitting said trigger alert signal from said mobile telecommunications switching office to said wireless communication device over a radio frequency (RF) network.

Applicant notes that it is impossible to interpret Yang as teaching or suggesting this subject matter. Yang's TV phone cannot be the surveillance device, since Yang teaches that it is a cell phone, which by definition would not transmit anything "over a standard telephone line." (Claim 18). A cell phone tower transmitting to Yang's TV phone cannot be the surveillance device, since Yang does not teach or suggest that a cell phone tower transmits a trigger to anything "over a standard telephone line." (*Id.*) A TV broadcaster transmitting to the TV phone taught by Yang also cannot be the surveillance device, since Yang also fails to teach or suggest that such a broadcaster transmits a trigger to anything "over a standard telephone line." (*Id.*)

The rejection of claim 18 is inappropriate because the Action has failed to establish a *prima facie* case of anticipation of the subject matter recited therein. For at least this additional reason, the rejection of claim 18 and should be reconsidered and withdrawn.

Claim 20:

Claim 20 is patentable over Yang for at least the same reasons given above in favor of the patentability of claim 17. Additionally, claim 20 recites “transmitting said trigger initialized digital image to said wireless communication device.”

In this regard, Applicant has already amply demonstrated that nothing in Yang teaches or suggests the surveillance device recited in claim 17 in which a trigger initialized digital image is generated. Accordingly, it is impossible for Yang to teach or suggest this additional subject matter relating to the transmission of the trigger initialized digital image.

The rejection of claim 20 is therefore inappropriate because the Action has failed to establish a *prima facie* case of anticipation of the subject matter recited therein. For at least this additional reason, the rejection of claim 20 and should be reconsidered and withdrawn.

Claim 21:

Claim 21 is patentable over Yang for at least the same reasons given above in favor of the patentability of claim 17. Additionally, claim 21 recites “assigning a unique identification to said surveillance device; and obtaining recognition from a plurality of service providers of said unique identification as an approved image source.” Nowhere in the cited portions of Yang, or anywhere else in Yang, is this subject matter taught or suggested.

The rejection of claim 20 is therefore inappropriate because the Action has failed to establish a *prima facie* case of anticipation of the subject matter recited therein. For at least this additional reason, the rejection of claim 20 and should be reconsidered and withdrawn.

Claims 22-24:

Claims 22-24 are patentable over Yang for at least the same reasons given above in favor of the patentability of claim 17. Additionally, claims 22-24 depend from claim 21 and recite further subject matter regarding the “unique identification” assigned to the surveillance device as recited in claim 21. Since Yang does not teach or suggest the subject matter of claim 21 anywhere, Yang *cannot* teach or suggest this additional subject matter.

The rejection of claims 22-24 is therefore inappropriate because the Action has failed to establish a *prima facie* case of anticipation of the subject matter recited therein. For at least this additional reason, the rejection of claims 22-24 should be reconsidered and withdrawn.

MPEP §§ 707.02 and 706.04

The MPEP requires that any application “which is up for the third or subsequent Office Action” should be approached by the Office “with a view to finally concluding its prosecution.” MPEP § 707.02. The MPEP further states that “every effort should be made to terminate [the] prosecution” for “[a]ny application that has been pending five years.” *Id.*

Applicant notes that the recent Office Action is the fifth Office Action received for the present application, which has been pending for more than five years. As such, every effort should be made to terminate prosecution of this application. Two years ago, the previous Examiner allowed original claims 17-31 after a thorough prosecution in accordance with this goal. (See Office Action dated 9/11/2007, p. 7).

With regard to these previous actions of the Examiner, the MPEP is very clear:

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, *an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something.*

MPEP § 706.04 (emphasis added) (citing to *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1449-50 (D. Mass. 2001)).

The current Examiner appears to have disregarded the policies of the MPEP by withdrawing original claims 17-31 from allowance, imposing a late Restriction Requirement, and imposing the present non-final rejection. (Office Actions dated 2/24/2009 and 6/10/2009). Such actions do not give “full faith and credit to the search and action of the previous examiner.” MPEP § 706.04. Additionally, the withdrawal of allowance of original claims 17-31 in light of the late Restriction Requirement was completely inappropriate in that it utterly ignored the MPEP’s requirement that claims be withdrawn from allowance only “in view of newly discovered references.” *Id.* The Examiner failed to cite any new art when withdrawing claims 17-31 from allowance. (Action dated 2/24/2009, p. 2). Moreover, the record plainly shows that the Examiner did not even perform a new search prior to withdrawing claims 17-31 from allowance. Rather, a new search was performed after withdrawing the claims from allowance for no apparent good reason.

In view of these principles, the Examiner’s statement in the Office Action of 2/24/2009 that “[t]he allowance of claims 17-31 is withdrawn and the following restriction requirement is made based on a new examination of the pending claims” is therefore completely inconsistent

with MPEP § 706.04 and remains unsupported by the MPEP or by U.S. patent laws and regulations. (Action dated 2/24/2009, p. 2).

The patent prosecution process was not designed to impose the burdens of “a new examination of the pending claims” on an individual inventor after his application has already been substantially examined and allowed. (Action dated 2/24/2009, p. 2). In addition to the fact that doing so is unwarranted by the USPTO rules and regulations, it is also extremely unfair to the inventor, on whom the Office should not impose the hardship of responding to additional Office Actions, in which the Examiner is simply “mak[ing] a new search in the mere hope of finding something.” MPEP § 706.04.

In summary, the actions taken by the Examiner in the two most recent Office Actions are unwarranted. Consequently, the recent Restriction Requirement and the present non-final rejections should be promptly withdrawn, and allowance of claims 17-31 is in order.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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